

Application No. 10/660,063
Preliminary Amendment and Response to the Final Office Action Dated June 26, 2007 and the
Advisory Action dated September 13, 2007

REMARKS/ARGUMENTS

Claims 1-31 are pending in this application. Claims 1, 15, and 29-31 are independent. Claims 1, 3, 6-7, 9, 13, 15, 17, 20-21, 23, 27, and 29-31 have been amended. Claims 2 and 16 have been cancelled.

Claim Rejection - 35 U.S.C. § 101

The Patent Office rejected claim 29 under 35 U.S.C. § 101 as lacking patentable utility. Applicant respectfully traverses the rejection. The Patent Office stated that one of ordinary skill in the art would not read into the limitations of the claim hardware that would enable claim 29 to perform the steps recited. Applicant respectfully disagrees. Amended claim 29 is directed to a computer readable set of instructions embodied in a tangible media or medium. Computers are only able to read instructions that are embodied on media readable by the computer. By the very definition of the words, a computer readable set of instructions must be embodied on a computer readable medium or other hardware and be executable by a processor or processing device. Thus, amended claim 29 has patentable utility and is directed to statutory subject matter under 35 U.S.C. § 101. Amended claim 29 is allowable and withdrawal of the rejection of claim 29 is respectfully requested.

Claim Rejection - 35 U.S.C. § 112

The Patent Office rejected claim 29 under 35 U.S.C. § 112 ¶ 1 as not being supported by either a credible asserted utility or a well established utility for the reasons set forth above. Applicant respectfully traverses. However, claim 29 has been amended and is now allowable.

Claims Rejections - 35 U.S.C. § 103(a)

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The Patent Office rejected claims 1-3, 7, 8, 13, 15-17, 21, 22, 27, and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Okada et al. (U.S. Patent No. 7,099,867) ("Okada") in view of Mandato et al. (U.S. Patent Publication No. 20010025280) ("Mandato"). Applicant respectfully traverses.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant respectfully submits amended claims 1 and 30-31 recite elements not disclosed, taught or suggested by any of the references cited by the Patent Office, either alone or in combination. For example, amended claim 1 generally recites an apparatus for adding context to a chat transcript utilizing means for assigning a verb to text of a first message and means for associating the verb with the user from which the first message is received. By contrast, Okada and Mandato fail to disclose an apparatus for adding context to a chat transcript utilizing means for assigning a verb to text of a first message and means for associating the verb with the user from which the first message is received. The combination that would result would still lack an apparatus for adding context to a chat transcript utilizing means for assigning a verb to text of a first message and means for associating the verb with the user from which the first message is received as required by amended claim 1. The references cited fail to disclose these limitations. At least a similar argument

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to those made above may be made for claims 15 and 29-31. Thus, independent claims 1, 15, and 29-31 are nonobvious under 35 U.S.C. § 103(a). For at least the above reasons, amended claims 1, 15 and 29-31 are allowable.

Based on at least the rationale above, Applicant contends that none of the references cited by the Patent Office against the present invention, either alone or in combination, teach, disclose, or suggest the above referenced elements as claimed in the claims of the present application, and therefore, the above-cited references do not preclude patentability of the present invention under 35 U.S.C. § 103(a). Applicant further contends that it would have not been obvious to one of ordinary skill in the art at the time of the present invention to combine or modify any of the above cited references to arrive at the present invention as claimed. As a result, a *prime facie* case of obviousness has not been established for independent claims 1, 15, and 29-31.

Amended independent claims 1, 15, and 29-31 are allowable based on at least the reasons discussed in the previous paragraphs. Claims 2-3, 7, 8, 13, 16-17, 21, 22, and 27 depend on independent claims 1, 15, and 29-31, which are allowable based on at least the rationale discussed in the previous paragraphs. Thus, dependent claims 2-3, 7, 8, 13, 16-17, 21, 22, and 27 are allowable based upon their dependence on allowable base claims.

Applicant respectfully requests entry of the amendments, and removal of all the pending rejections under 35 U.S.C. § 103(a) is respectfully requested. No new matter has been added by the amendments. Support for the amended claims may be found throughout the specification.

CONCLUSION

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In light of the forgoing amendments and arguments, reconsideration of
the claims is hereby requested, and a Notice of Allowance is earnestly
solicited.

Respectfully submitted, on behalf of,

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